

Amendment under 37 C.F.R. §1.111  
Application No. 10/536,997  
Attorney Docket No. 052644  
Page 14

### **REMARKS**

Claims 1-26 are currently pending in the application. The specification and claims are hereby amended.

Applicants gratefully acknowledge that claims 15 and 26 would be allowable if rewritten in independent form including all of the base claim limitations. In response, applicants have amended these claims into independent form.

Applicants have also amended claim 14 to correct a punctuation error. A period was inserted at the end of the last sentence of the claim. Applicants have also elected to amend claim 1 in order to make the claim clearer.

### **Specification**

The Office Action had objected to lines 18 and 19 of page 2, wherein the reference citations to two Japanese patent publications were listed. Applicants have amended the specification and moved the reference citations to immediately after where they are referenced. Applicants have moved the reference citation of Patent Publication 2, to the end of the sentence on line 10 of page 2, and moved the citation to Patent Publication 1, to the end of the sentence on page 1, line 19.

**On the Merits:**

Claims 1, 2, 3, 7, 8, 16 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Takada* (US 6,373,258) in view of *Sotaro* (JP 2001-084905) (provided in the information disclosure statement). The Office Action asserts that the first elements of independent claims 1 and 16 are disclosed by *Takada*, and that *Sotaro* discloses the elements of moving each sensor electrode with a given gap relative to the target patterns on a circuit board having a bar-like shape with a given width.

A “target pattern” is referred to in the preamble of claims 1 and 16 as having first and second opposite ends included in an inspection region, and arranged in lines.

*Sotaro* does not disclose the previously cited elements of claims 1 and 16, namely that both probes/sensors do not touch the target pattern, and that both probes/sensors maintain a gap between themselves and the target pattern. *Sotaro* discloses that one probe is a “non-contact” probe, while the other probe is a “contact probe.” *Sotaro* abstract, lines 4 and 5. Furthermore in Figure 3, element 21 clearly shows the “contact probe.” A “contact probe” means that the probe literally touches and comes in physical contact with the target pattern to be tested.

Claim 1 requires a “given gap relative to each of said target positions.” Claim 16 requires “that each surface of said supply and sensor electrodes is spaced apart from each surface of said target patters.” In other words, each sensor electrode must have a gap between the electrode and the surface to be tested. The Office Action uses *Sotaro* to disclose a “given gap relative to each of the conductive patterns on a circuit board.” This may explain the Office Action’s reference to

Amendment under 37 C.F.R. §1.111  
Application No. 10/536,997  
Attorney Docket No. 052644  
Page 16

element 12 of Figure 3 of *Sotaro*. Clearly a gap between conductive patterns, of the circuit board to be tested, is not the same as a gap between each sensor electrode and a target pattern. Applicants have amended claim 1 in order to improve the clarity of the claim.

Applicants submit that the dependent claims based on independent claims 1 and 16 should be allowable if the rejections to claims 1 and 16 are withdrawn.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**

  
Stephen G. Adkian

Attorney for Applicants  
Registration No. 32,878  
Telephone: (202) 822-1100  
Facsimile: (202) 822-1111

SGA/DMH/meu